

Attorney Docket No.: IU-0008
Inventors: Kwon, Byoung
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REMARKS

The Examiner has stated that claims 1-21 are pending. It is respectfully pointed out that claims 1-8 and 17-21 were canceled and new claims 22-25 added by a Preliminary Amendment filed on September 30, 2002. Therefore, claims 9-16 and 22-25 are pending in this application. Claims 9, 11 and 22 have been amended. No new matter has been added. Applicant is respectfully requesting reconsideration of the restriction requirement in view of the following remarks.

The claims of the present application have been subjected to a Restriction Requirement under 35 U.S.C. §121 by the Examiner in this case. The Examiner suggests that restriction of the present invention into the following groups is required:

Group I, claims 1-5, drawn to polynucleotides;
Group II, claims 6-8, 17, 18, drawn to polypeptides;
Group III, claims 9-12, drawn to antibodies;
Group IV, claims 13-16, 21, drawn to methods of enhancing/inducing T-cell proliferation; and
Group V, claims 19 and 20, drawn to methods of identifying binding partners.

The Examiner suggests that while there are no provisions under the section for "Relationship of Inventions" in MPEP §806.05, the inventions listed as Groups I-V are distinct from each other in that Groups I-III are directed to products that are both physically and functionally distinct, and are not required for one for the other, and are therefore patentably distinct. It is suggested that Group I is distinct from the other groups in that protocols and reagents for preparing and using a protein of Group I are materially distinct and separate from the other

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groups. The Examiner suggests that Group II is distinct from the other groups in that a DNA of Group II can be used in methods that are related or materially distinct and separate from the other groups. The Examiner suggests that Group III is distinct from the other groups in that an antibody can be used in methods that are related or materially distinct and separate from the other groups.

The Examiner further suggests that while there are no provisions under the section for "Relationship of Inventions" in MPEP §806.05, Groups IV and V are directed to methods that are both physically and functionally distinct, and are not required for one for the other, and are therefore patentably distinct. The Examiner suggests the Group IV requires a method for enhancing T-cell activation which is not required by Group V, and Group V requires a method to identify ligands of a polypeptide which is not required by Group IV.

The Examiner acknowledges that Group I and Group II claims are related to the methods of Groups IV and V as product and process of use, but that they are patentably distinct because polynucleotides and polypeptides, respectively, can be used in ways that are materially and functionally different than each of methods of Groups IV and V. Further, the Examiner acknowledges that Group III claims are related to the methods of Group IV as product and process of use, but they are patentably distinct because antibodies can be used in ways that are materially and functionally different from the methods of Group IV. Applicant is required to elect one of the Groups to be examined.

The Examiner further suggests that Claims 1-4, 6, 9, 11 and 13-21 are generic to a plurality of disclosed patentably distinct

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species comprising polypeptides of murine and human 4-1BB proteins and a search of one could not be relied upon, solely, to provide art that is anticipatory or that might render obvious any other, and to search more than one species in a single application would be unduly burdensome. Applicant is required to elect a single disclosed species.

In an earnest effort to be completely responsive and to facilitate the prosecution of this case, Applicant hereby elects to prosecute Group III, claims 9, 10, 11 and 12 drawn to antibodies, classified in class 530, subclass 7.21. Further, Applicant elects to prosecute antibodies which specifically recognize the mouse 4-1BB receptor. In accordance with this species election, Applicant has amended the claims and has included herein a listing of all claims readable thereon.

Respectfully submitted,



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